The restriction requirement of a single amino acid sequence represents improper restriction of a Markush group.

The restriction of claims 6-8 in Group I to a single amino acid sequence also represents the restriction of subject matter **within** Markush claims, which is also improper. Claims 6-8 each recite a Markush group of amino acid sequences. Claims 6 and 7 both recite a group consisting of cCAF, IL-8, or MGSA, and claim 8 recites a group consisting of SEQ ID NOS:8, 9, 10, and 11.

Restriction practice relating to Markush claims is governed by M.P.E.P § 803.02, which states:

> This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, **the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability**. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.
>
> As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

> On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry. (Emphasis added.)

Thus, the M.P.E.P. makes it clear that claims 6-8 cannot properly be restricted by requiring election of one element of the Markush groups contained in each claim. At most, the Patent Office can require an election of one of the species recited in claims 6-8. Withdrawal of the single amino acid sequence restriction requirement relating to claims 6-8 is therefore respectfully requested. If the Examiner decides to withdraw the single amino acid sequence restriction requirement, and instead require an election of species, Applicants provisionally elect the species drawn to IL-8. The claims reading on the elected species are 1-8, 19, and 20.

Applicant reserves the right to appeal restriction.

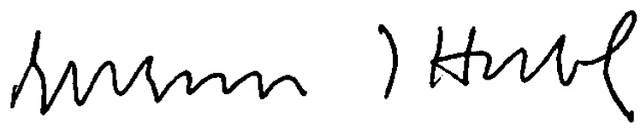
Because restriction of claim Group I to a single amino acid sequence, e.g., IL-8, is tantamount to a rejection and a refusal to examine the claims within the group as drafted, as articulated in *Haas I*, this action is appealable. Applicants note that the CCPA has explicitly held that review of the improper restriction of a single claim is within the jurisdiction of the Board of Patent Appeals and Interferences and the federal courts. This is in contrast to the review of ordinary restriction requirements, which are not generally subject to appellate review. See, *In re* Haas I, *supra*. Accordingly, Applicants expressly reserve the right to appeal this decision to the Board of Appeals and/or the Federal Courts in the event that the restriction requirement is made final.

CONCLUSION

In view of the foregoing traversal, Applicants believe that the restriction requirement relating to a single amino acid sequence (e.g., IL-8) within an elected Group drawn to amino acid sequences (e.g., Group I) is improper. Applicants respectfully request that this restriction requirement be withdrawn. As stated earlier, Applicants elect proposed Group I (claims 1-8, 19, and 20). Applicants further provisionally elect the amino acid sequences drawn to IL8, SEQ ID NOS:8 and 9, with traverse.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to contact the undersigned at (510) 769-3505, direct.

Respectfully submitted,



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